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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,213	12/31/2003	Ming-chih Tsai	3626-0253P	6717

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER

HAM, SEUNGSOOK

ART UNIT PAPER NUMBER

2817

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*AK*

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/748,213	TSAI, MING-CHIH	
	<b>Examiner</b>	<b>Art Unit</b>	
	Seungsook Ham	2817	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18 is/are allowed.
- 6) ☒ Claim(s) 19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. <u>060105</u>  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The newly amended claims 19 and 20, "wherein the terminal of the wires of the inductance coil and **the other terminal of the grounded wire not connected to the conductive film of the second surface** are facing toward a direction that is parallel (claim 20, "perpendicular") to the ceramic capacitance board" does not have support in the original disclosure. It appears from figures 3A-5C and the original specification that there is only one ground terminal (see figs. 4C and 5C which shows only a single ground terminal between the capacitors CY), thus, there is no support in the original disclosure for "the other terminal of the grounded wire not connected to the conductive film of the second surface."

Claims 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The newly amended claims 19 and 20 indicate that there are two ground terminals for the grounded wire. However, it appears from figures 3A-5C and the original specification that there is only one ground terminal (see figs. 4C and 5C which shows only a single ground terminal between the capacitors CY), thus, one skill in the art would not know where "the other terminal of the grounded wire" is located at.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 19 and 20, line 2, "the terminal" lacks antecedent basis.

***Allowable Subject Matter***

Claims 1-18 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: Prior art does not show nor suggested a filter having the structure of a ceramic capacitance board recited in claim 1, lines 3-5 ("a capacitance board with a plurality of separate electrodes...on a second surface") in conjunction with a conductive film capacitor and an inductance coil, and the wire connections among the inductance coil, conductive film capacitor and the ceramic capacitance board as recited in claim 1, lines

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10-14. Claim 3, lines 3-5, and lines 10-15, and claim 5, lines 4-7 and lines 10-16 recite the similar limitations.

### ***Response to Arguments***

Applicant's arguments filed on 5/10/05 have been fully considered but they are not persuasive.

The applicant indicated that the examiner agreed to the changes in claims 19 and 20 in a telephone interview on March 10, 2005. It should be noted that the examiner left a voice mail with a partial agreement to the changes and requested a phone call for clarification; however, the examiner never did receive a return phone call from the applicant's representative. Despite the issue of whether the examiner accepted the changes to the claims 19 and 20, after the further review of the claims, the claims are no longer allowable based on 35 USC 112, first paragraph rejections (see above).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seungsook Ham whose telephone number is (571) 272-2405. The examiner can normally be reached on Monday-Thursday, 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pascal can be reached on (571)-272-1769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Seungsook Ham  
Primary Examiner  
Art Unit 2817

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